




UNITED STATES PATENT AND TRADEMARK OFFICE


UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,519	12/05/2000	Robert G. Harrison	005556.P021	6790

26263 7590 08/22/2006

SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

HUYNH, SON P

ART UNIT PAPER NUMBER

2623

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/730,519	Applicant(s) HARRISON ET AL.	
	Examiner Son P. Huynh	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-19 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8, 10-19, 22-24 have been considered but are moot in view of the new ground(s) of rejection.

Claims 9 and 20-21 have been canceled.

Claim Rejections - 35 USC § 112

2. Claims 1-8, 10-19, 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 4 and 19 recite the limitation "wherein when the appliance is in the Internet mode the appliance is not in the TV mode, and when the appliance is in the TV mode the appliance is not in the Internet mode and not capable of bringing up web pages from the Internet." that is not support by the specification. The specification merely describes user select a button to switch mode (i.e. with the appliance on and in the Internet mode, user presses TV mode button 78 on remote control or keyboard 20

Art Unit: 2623

to switch into TV mode – page 9, paragraphs 4-7); nowhere in the specification describes “***wherein when the appliance is in the Internet mode the appliance is not in the TV mode, and when the appliance is in the TV mode the appliance is not in the Internet mode and not capable of bringing up web pages from the Internet***” as claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10-19, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 6,219,042) in view of Alexander et al. (US 6,177,931).

Regarding claim 1, Anderson discloses an appliance (set top box 20, TV 22 and remote control 24) which only has an Internet mode of operation and a TV mode of operation (figures 1-3):

the appliance having the capability of connecting the appliance to the Internet and concomitantly displaying a worldwide web home page (figures 3-4);

the appliance also having the capability of bringing up and displaying pages which are directly or indirectly linked to the home page (see including, but are not limited to, figure 3, col. 5, lines 15-23);

the appliance further has capability, when the appliance is switched out of its Internet mode into its TV mode and then back into the Internet mode, of returning to a web page displayed when the appliance was switched out of the Internet mode (the terminal is configured to maintain current state-connection status, active web page, history, etc.- of the Internet mode when a transition to television mode occurs. This allows a user to switch back and forth between modes without having to start the browsing process over each time... col. 5, lines 33-43), wherein when the appliance is in the TV mode the appliance is not in the Internet mode and not capable of bringing up web pages from the Internet (i.e. when in TV mode, display full screen television configuration in which the television program displays on the entire television screen – see including, but are not limited to, col. 5, lines 4-9, col. 6, lines 10-11, lines 20-26). Anderson also discloses when the view button is used to toggle from a television mode configuration in which no television programming is display to Internet mode (see col. 6, lines 4-6). However, Anderson does not specifically disclose when the appliance in the Internet mode the appliance is not in the TV mode.

Alexander discloses when the appliance in the Internet mode the appliance is not in TV mode (e.g. EPG switches to full screen to display of the Internet web site in response to user selection to switch to Internet mode— col. 18, lines 37-39). Therefore, it would have

Art Unit: 2623

been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson to use the teaching as taught by Alexander in order at least to enlarge information of the website on the screen/ or to reduce interference of web site content displayed on the screen.

Regarding claim 2, Anderson in view of Alexander teaches an appliance as discussed in the rejection of claim 1. Anderson further discloses the appliance also has the capability, selectable by a user of the appliance, of returning to the worldwide web home page when the appliance is switched from the TV mode to the Internet mode (col. 5, lines 32-43).

Regarding claim 3, Anderson in view of Alexander teaches an appliance as discussed in the rejection of claim 1. Anderson further discloses the appliance, if switched out of the TV mode and then back to the TV mode, will return to the channel which was active when the appliance was switched out of the TV mode (if the first configuration is a viewing configuration, then the configuration is not changed and configuration of the television mode is not changed when switch to Internet mode and back to television mode – col. 6, lines 5-45. As a result, the channel will stay the same as before the appliance was switched).

Alternatively, Alexander also discloses the appliance, if switched out of the TV mode and then back to the TV mode, will return to the channel which was active when

Art Unit: 2623

the appliance was switched out of the TV mode (see including, but is not limited to, col. 7, lines 5-15).

Regarding claim 4, the redundant claim limitations have been addressed in claim 1.

Anderson further discloses an input device (24-figure 6) for transmitting data to the integrated unit by signals in a selected part of the electromagnetic spectrum (figure 6, col. 3, lines 4-12), wherein the input device has the following controls:

back button (figure 6) inherently reads on Back controls for moving backwards through Internet web pages (figure 6, also please refers to US 6,496,205 for detail description of all buttons on the remote control 24);

up and down buttons (figure 6) inherently reads on a set of up and down scroll buttons controls for moving a page relative to a screen component of the appliance

a set of LEFT, RIGHT, UP and DOWN arrows 106,102,100,104 (figure 6, col. 5, lines 24-32) reads on a second, separate set of LEFT, RIGHT, UP and DOWN buttons for moving a cursor about the screen component of the appliance; and

“GO” button 108 (figure 6, col. 5, lines 25-42) reads on a GO control used to bring up a web page indicated by the cursor (highlight by moving arrows 100-106).

Anderson does not explicitly disclose Next controls for moving forwards through the page and Left, Right scroll controls.

Alexander further discloses the viewer’s remote control device provides “Next” and “Previous” keys (col. 10, lines 56-30) read on Next and Back controls respectively; and Left, Right scroll controls (col. 9, lines 1-16; col. 10, lines 30-42; col. 15, line 40-col.

16, line 26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson to use the teaching as further taught by Alexander in order to provide a user with an easier and more convenient means for navigation/scroll through web pages vertically or horizontally.

Regarding claim 5, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson further discloses the input device (24) has the capability of generating and transmitting signals in the infrared portion of the electromagnetic spectrum (see including, but is not limited to, col. 3, lines 5-11).

Regarding claims 6-8, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson further discloses the input device (24) is a remote control, or a keyboard (see including, but is not limited to, col. 3, lines 5-11); the input device has exactly two mode selection controls, the controls being a TV control and an Internet control (using "View" button 110 which allows the user to toggle, or switch, back and forth between the Internet and television modes – col. 5, lines 33-35).

Regarding claim 10, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson further discloses the input device (24) has an OPTIONS button (figures 6-8) reads on the claim OPTIONS control operable to bring up on the screen component a menu of choices available to a user of the appliance, the

Art Unit: 2623

OPTIONS control being usable in both TV and Internet modes of operation of the appliance.

Alternatively, Alexander also discloses the input device has an GUIDE/Menu icon 35 (figures 2, 3 col. 7, lines 30-45) reads on the claimed "OPTIONS control for"

Regarding claims 11-12, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson in view of Alexander does not specifically disclose a stop control operable with the appliance in its Internet mode of operation to terminate the downloading of Internet file and a pause control operable with the appliance in its Internet mode of operation to first stop the downloading of a web file and to then cause the downloading of the file to continue from the point where it was stopped.

Official Notice is taken it would have been well known to pause and stop or pause the downloading of the Internet page to provide a user with an option of stopping a download or to pause the download for time convenient for a user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson in view of Alexander to include the claimed limitation of stopping or pausing a download to provide a user with an option and more control with respect to downloading.

Regarding claims 13-14, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson further discloses the input device (24)

Art Unit: 2623

has a numerical keypad (figure 6), a keyboard with keys corresponding to the letters of the alphabet (keys corresponding to letters on the standard keyboard – col. 3, lines 6-7).

Regarding claims 15-16, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson further discloses the set top box may be built into television set 22 as an integral unit (col. 3, lines 2-3). It is obvious to one of ordinary skill in the art that the integrated unit (television set 22) is of the stand alone unit type and is constructed to sit on a horizontal surface, has the capability of being mounted to an overhead structure, or wherever comfortable to a user.

Regarding claim 17, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson further discloses the capabilities of the integrated unit are provided by operating components which include:

- a video switch/display driver (met by video encoder, ASIC, CPU, RAM, ROM – figure 4);

- an audio switch/speaker driver (met by audio DAC, ASIC, CPU, RAM, ROM – figure 4);

- an INTERNET controller (ISDN modem, telephone modem – figure 4) operatively connected to the video switch/display driver and the audio switch/display driver; and

- a television controller/digital tuner (met by TV I/F 54 – figure 4) also operatively connected to the video switch/display driver and the audio switch/display driver.

Regarding claim 18, Anderson in view of Alexander discloses an appliance at discussed in the rejection of claim 4. Anderson further discloses the television controller/digital tuner has a connection for a television cable or antenna (e.g. for receiving broadcast video signal such as an NTSC, PAL, SECAM or other TV system video signal – figures 1, 4; col. 3, line 18-64) and the Internet has telephone lines connections, ISDN connections, or any other similar type of connection such as cable and forward channels (figures 4-5, col. 4, lines 10-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made that the Internet controller uses Ethernet and USB in order to connect a readily available communication standard and for transmit Internet data faster.

Regarding claim 19, the redundant claim limitations have been addressed in the rejection of claim 1. Anderson further discloses the remote control 24 is operated by the user to operate the terminal. The terminal receives commands from remote control 24 (col. 3, lines 4-12). The remote control comprises power buttons (figure 6). Thus, the appliance inherently can be turned on and off (i.e. using the remote control).

Alternatively, Alexander also discloses the appliance can be turned on and off (col. 7, lines 1-17). The first thing that the viewer see when the viewer turns the television on is either EPG mode/Internet mode to television mode depends on the default mode or EPG set up procedures/or instruct by the users (see including, but is not limited to, col. 7, lines 1-17). Thus, Alexander discloses a TV mode control for selecting a TV mode of operation, the appliance having capability of coming on the TV mode if, when the

Art Unit: 2623

appliance is off, a user activates the TV mode control (e.g. view override the EPG Grid Guide default mode by selecting to automatically enter the Television Mode whenever the viewer is first turns on the television). However, Anderson in view of Alexander does not specifically disclose when the appliance is off, a user activates the Internet mode control to select Internet mode and the appliance having the capability of coming on in the Internet mode. Official Notice is taken selecting a Internet mode when the device is off and the device has capability of coming on in the Internet mode is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson in view of Alexander to use the well-known teaching in the art of providing a device that coming on in Internet mode if the Internet mode is activated when the device is off in order to access the Internet mode quicker.

Regarding claim 22, Anderson further discloses the appliance which has the capability, when the appliance is switched out of its Internet mode and then back into the mode, of returning to a web page displayed when the appliance was switched off of the Internet mode (col. 5, lines 32-43).

Regarding claims 23 and 24, the additional limitations as claimed correspond to the additional limitations as claimed in claims 2-3, and are analyzed as discussed with respect to the rejection of claims 2 -3.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

White et al. (US 6,496,205) discloses user interface for controlling audio function in a web browser.

Bertis et al. (US 5,867,154) discloses method and apparatus to select a display area within a data processing system.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 9:00 - 6:30.

Art Unit: 2623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Son P. Huynh

August 14, 2006


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600